

REMARKS

The Examiner's indication of allowable subject matter of claims 8 and 20 in paragraph 8 of the Office Action is noted with appreciation. Claim 2 is also believed to include allowable subject matter as there is no rejection of claim 2 in the Office Action.

Claims 1-9, 14-21, 27 and 29-36 are pending in the application. Allowable claim 8 has been rewritten in independent form including all limitations of base claim 1 in the manner kindly suggested by the Examiner in paragraph 8 of the Office Action. Allowable claim 20 has been rewritten in independent form including all limitations of base claim 1 and intervening claim 19 in the manner kindly suggested by the Examiner in the Office Action. Claim 2 has been rewritten in independent form including all limitations of base claim 1. Claim 21 has been rewritten in independent form including all limitations of base claim 1 and intervening claim 19. Claims 10-13 and 28 have been cancelled without prejudice or disclaimer. Non-elected claims 22-26 have been cancelled. Claims 3-6, 14-16, 18 and 27 have been amended to better define the claimed invention. Claim 9 has been amended to depend from claim 1. Claims 29-36 have been added to provide Applicants with the scope of protection to which they are believed entitled.

The specification and Abstract have been amended in compliance with commonly accepted US patent practice.

No new matter has been introduced through the foregoing amendments.

Applicants note that the Office Action does not include a copy of the PTO-1449s submitted with the information disclosure statements filed March 8, 2002 and November 18, 2002. Applicants respectfully request that the information submitted in the above identified IDS be considered and a copy of the PTO-1449s, with the Examiner's initials placed adjacent to the citations on the PTO-1449s, be returned to Applicants' representative in the next office communication.

The *35 U.S.C. 112, second paragraph* rejection is believed overcome in view of the above amendments.

The *35 U.S.C. 102(b)* rejection of claims 1, 3, 4, 9, 12-14, 18, 27 and 28 as being anticipated by U.S. Patent No. 4,012,878 to *Ellingson* is noted. Independent claim 1 has been amended to overcome this rejection. In particular, amended claim 1 now requires that each of said second arms be connected to one of said first arms by a connecting portion to define a half of the edge protector, said half having a generally **S-shaped profile** in cross section. *Ellingson* fails to teach or suggest the added claim feature, as can be seen in FIG. 2 of the patent. Amended independent claim 1 is thus patentable over *Ellingson*. Claims 3, 4, 9, 14, 18, and 27 should be considered patentable for at least the same reason.

The *35 U.S.C. 102(b)* rejection of claims 9, 10-11, 13-14, 18-19, 21 and 28 as being anticipated by U.S. Patent No. 5,517,794 to *Wagner* is noted.

The rejection of at least claim 21 is traversed because *Wagner* clearly fails to teach or disclose each and every element of the rejected claim, i.e., the claim requirement that said retaining means comprise one or more of **shrink-wrap, rope, string or straps**. *Wagner* deals with the field of exterior siding for structures or buildings. See column 1, lines 8-10 and column 5, lines 36-39. *Wagner* fails to explicitly the limitation of claim 21 because in *Wagner* corner member 12 is retained in place by nails 84. See Fig. 7 of *Wagner*. The patent also fails to teach the claim limitation through inherency because the claim feature does not necessarily flows from the teachings of the applied patent. In addition, a person of ordinary skill in the art would not have been motivated to modify *Wagner* to arrive at the invention of claim 21 because, generally, vinyl siding is not applied to the structure or building to be protected by shrink-wrap, rope, string or straps. Accordingly, claim 21 is patentable over *Wagner*. Withdrawal of the anticipatory rejection and allowance of claim 21 are believed appropriate and therefore courteously solicited.

The rejections of the remaining claims, i.e., claims 9, 10-11, 13-14, 18-19, and 28 are either moot or believed overcome in view of the new dependency of claim 9.

The *35 U.S.C. 103(a)* rejections of claims 5-7, and 15-17 are believed overcome in view of the amendments made to independent claim 1. Of particular note, the Examiner obviousness rejections of claims 5-6 and 15-16 are deemed inappropriate because a *prima facie* case of obviousness has not been established. The examiner has not presented any evidence that would have led one of ordinary skill in the art to modify the relevant teachings of the applied reference to arrive at the claimed invention. In that regard, the mere fact that a difference (between the teachings of the prior art and the claimed subject matter) does not solve any recognized problem does not, *ipso facto*, make that difference obvious under *35 U.S.C. 103*.

Claims 8 and 20 include the indicated allowable subject matter and should be allowed. Claim 2 should also be allowed in the absence of art rejections.

New claims 29-34 depend from claim 1, and are considered patentable at least for the reason advanced with respect to amended claim 1. Claims 29-34 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art, as will be apparent to the Examiner upon reviewing these claims.

New claims 35-36 depend from allowable claim 20, and should also be considered allowable. Claims 35-36 further include other features of the invention neither disclosed, taught nor suggested by the applied art, as will be apparent to the Examiner upon reviewing these claims.

Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to

facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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